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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,310	07/22/2004	Wolfgang Fugel	188.550	9173
47888	7590	03/07/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			LE, DAVID D	
			ART UNIT	PAPER NUMBER
			3681	
DATE MAILED: 03/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/502,310

Applicant(s)

FUGEL, WOLFGANG

Examiner

David D. Le

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on N/A is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/502,310, filed on 22 July 2004. Claims 1-7 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - New Declaration and Power of Attorney, received on 03/29/05
  - Foreign Priority Document, received on 07/22/04
  - Information Disclosure Statement, received on 07/22/04

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) filed on 22 July 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. The copy of the cited foreign patent document "DE 35 02 276 C1" was not submitted. Accordingly, the IDS, filed on 22 July 2004, is partially considered and a copy of which is attached.

***Oath/Declaration***

4. The current declaration, filed on 29 March 2005, is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The current declaration, filed on 29 March 2005, is defective because it identifies the specification as being attached hereto, which is inaccurate. The present specification was filed on 22 July 2004 and was not attached with the current declaration.

***Drawings***

5. The present specification, page 5, discloses drawings, Figs. 1-7. However, the drawings, Figs. 1-7, were not filed. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

***Specification***

6. The disclosure is objected to because of the following informalities:
- Pages 3, line 1 of the second paragraph, recites, "the invention achieves this object according to the characterizing part of claim 1". It is not clear whether applicant is referring to the originally filed claim 1 or the currently amended claim 1.

- Page 4, line 6, recites “advantageous features of the stop washer are described in sub-claims 2 to 7”. It is not clear whether applicant is referring to the originally filed claims 2 to 7 or the currently amended claims 2 to 7.
- Page 4, line 7, recites, in part, “according to claim 2”. It is not clear whether applicant is referring to the originally filed claim 2 or the currently amended claim 2.
- Page 4, line 12, recites, in part, “according to claim 3”. It is not clear whether applicant is referring to the originally filed claim 3 or the currently amended claim 3.
- Page 4, line 16, recites, in part, “according to claim 4”. It is not clear whether applicant is referring to the originally filed claim 4 or the currently amended claim 4.
- Page 4, line 20, recites, in part, “according to claim 5”. It is not clear whether applicant is referring to the originally filed claim 5 or the currently amended claim 5.
- Page 4, line 23, recites, in part, “according to claim 6”. It is not clear whether applicant is referring to the originally filed claim 6 or the currently amended claim 6.
- Page 5, line 1, recites, in part, “according to claim 7”. It is not clear whether applicant is referring to the originally filed claim 7 or the currently amended claim 7.

Appropriate correction is required.

***Claim Objections***

7. Claim 1 is objected to because of the following informalities:

- Line 3 recites the limitation “its reception bore”. This limitation should be amended as i.e., --a reception bore--.
- Lines 6-7 recites the terms “being assured”. The terms appears to be improperly utilized and should be amended.
- Line 7, “an axial” should be --an axial lubricant passage bore--.
- Line 9, the term “communicate” appears to be improperly utilized and should be amended.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 1:**

- Line 4 recites the limitation “delimits planet gears on both sides”. Since the disclosed planet gear 6 has many sides, it is not clear which sides are the “both sides” that applicant is referring to.

- Line 7 recites the limitations “an axial” and “a radial lubricant passage bore”.  
Since applicant has not properly defined the orientation, i.e., the axis or axes, of the lubricant passage bore, it is unclear which directions that applicant is referring to by the terms “axial” and “radial”.
- Line 8 recites the limitation “axial openings of the stop washer”. Since applicant has not defined the orientation of the stop washer, it is unclear which direction is an axial direction of the stop washer.
- Line 9 recites the limitation “inner axial openings”. Since applicant has neither defined the orientation of the stop washer nor the shape of the stop washer, it is unclear what applicant is referring to by this claimed limitation.
- Lines 12-13 recite “outer axial openings are arranged offset radially outwards between the inner axial openings”. Since applicant has neither defined the orientation nor the shape of the stop washer, it is unclear what applicant is referring to by this claimed recitation.
- Line 14 recites the limitations “the region” and “the rolling elements”. There is insufficient antecedent basis for these limitations in the claim.
- Lines 15-16 recite the limitation “the end face”. There is insufficient antecedent basis for this limitation in the claim.

Claim 2:

- Lines 2-3 recite the limitation “a peripheral dimension”. It is unclear what applicant is referring to by this claimed limitation.

Claim 5:

- Line 3 recites the limitation “the corners”. There is insufficient antecedent basis for this limitation in the claim.

Claim 6:

- Lines 2-3 recite the limitation “wherein being made out of sheet metal by punching.” It is unclear what object is being made out of sheet metal by punching.

Claim 7:

- Lines 2-3 recites the limitation “wherein it is provided with a friction-reducing coating.” It is unclear what applicant is referring to by “it”.

Note:

It has been noted that the present claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.



***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 5,489,255 to Hinckley et al.**

*Claims 1-7:*

Hinckley (i.e., Fig. 3; column 2, line 1 – column 3, line 21) discloses a thrust washer comprising:

- A reception bore (i.e., Fig. 3, element 34);
- A plurality of inner axial openings (i.e., Fig. 3, element 32);
- A plurality of outer axial openings (i.e., Fig. 3, element 30);
- Wherein the peripheral dimension of the outer axial openings diminishes in radially outward direction (i.e., Fig. 3);
- Wherein the outer axial openings are open to the outside in radial direction (i.e., Fig. 3);
- Wherein the outer axial openings are open to the outside in radial direction through corresponding constrictions (i.e., Fig. 3); and
- Wherein the corners of the axial openings are rounded (i.e., Fig. 3).

Note:

In claim 6, the method of making the stop washer is not germane to the issue of patentability of the stop washer itself. Therefore, this limitation has not been given patentable weight.

***Conclusion***

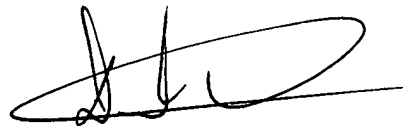
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fujioka et al. (U. S. Patent No. 4,480,492) teaches a lubrication conduit in a pinion gear carriage for an automatic transmission, as shown in Figs. 3-11.
- Fujioka (U. S. Patent No. 5,302,160) teaches a planet-pinion carrier assembly having washers (20 and 22) and lubricating passages, as shown in Fig. 1.
- Tanaka et al. (U. S. Patent No. 5,480,362) teaches double planetary carrier having washer (21), oil plate (7), and lubricating passage (24), as shown in Fig. 1.
- Brassai et al. (U. S. Patent No. 5,702,320) teaches planet gear carrier having washer and lubricating passage, as shown in Fig. 1.
- Faass et al. (U. S. Patent No. 5,795,258) teaches planet washer, as shown in Fig. 1.
- Taha et al. (U. S. Patent No. 5,928,105) teaches a planet carrier assembly with stationary washer members, as shown in Fig. 1.
- Zelikov et al. (U. S. Patent Application Publication No. US 2004/0023749 A1) teaches a carrier assembly comprising washers (24 and 26), as shown in Fig. 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David D. Le  
Examiner  
Art Unit 3681  
03/04/06

ddl